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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,345	01/20/2000	Evgeniy M. Getsin	LACTP009	4291

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CHICAGO, IL 60603-3406

EXAMINER

MA, JOHNNY

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/488,345

Applicant(s)

GETSIN ET AL.

Examiner

Johnny Ma

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.8.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "908"; page 32, line 19. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: "135" of Figure 1. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 9-14, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kinney et al. (US 5,808,662).

As to claim 1, note the Kinney et al. reference that discloses synchronized, interactive playback of digital movies across a network. The claimed "providing an event stored in a

memory storage device” is met by “Media file 115 is a storage device that contains enough memory to store a movie...Movie data is transferred to the media filed prior to viewing by the participants” (Kinney et al. 3:42-59). The claimed “connecting the client apparatuses and a host computer to a network” is met by “...network 100 includes a plurality of computer-implemented playback systems 105, 107 and 109” (Kinney et al. 3:16-21). The claimed “transmitting information from the host computer to the memory storage device utilizing the network for allowing the simultaneous playback of the event on each of the client apparatuses” is met by “[c]ommunication between participants takes place by the transfer of a number of data structures, or ‘events’, that are transferred over network 160. Events are also referred to as playback functions. The function of transferring events is performed by transport control logic 170” (Kinney et al. 36-40) and “[I]n a preferred embodiment, the first participant is considered the ‘master’ and therefore only the first participant responds to hello events” (Kinney et al. 8:11-14).

As to claim 2, the claimed “wherein the event includes a video and audio presentation” is met by “[t]he present invention provides a system and method for synchronized playback and control of a movie” (Kinney et al. 2:66-67) wherein movie track types include image track and audio track (Kinney et al. 3:5-6).

As to claim 3, please see rejection of claim 2.

As to claim 4, the claimed “wherein the network is a wide area network” is met by “[c]ommunication channel 160 can take many forms, including a conventional telephone line with modem, a local area network (LAN) or wide area network” (Kinney et al. 3:19-21).

As to claim 5, the claimed “wherein the information includes a start time when the playback of the event is to begin on each of the client apparatuses” is met by “if the event is a

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hello event...Block 270 forwards a seek event to the participant that is joining the viewing session in order to synchronize the new participant with the other participants” (Kinney et al. 8:9-18).

As to claim 9, the claimed “further comprising the step of receiving input from the user, and altering the playback based on the input” is met by “[c]ontroller 170 allows a participant to control the viewing of the movie or to annotate the movie” (Kinney et al. 4:14-16) wherein “[s]pecific actions that the participant can initiate are, for example, normal playback, stop, fast and slow reverse, fast and slow forward, and seek” (Kinney et al. 4:42-44).

As to claims 10-14 and 18, please see rejections of claims 1-4 and 9 respectively, where the Kinney et al. reference discloses it should be understood that embodiments of the present invention can be implemented in hardware, software or a combination thereof. In such embodiments, the various components and steps are implemented in hardware and/or software to perform the functions of the present invention (Kinney et al. 6:47-51).

As to claim 19, please see rejection of claim 1 where the Kinney et al. reference discloses it should be understood that embodiments of the present invention can be implemented in hardware, software or a combination thereof. In such embodiments, the various components and steps are implemented in hardware and/or software to perform the functions of the present invention (Kinney et al. 6:47-51).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7, 8, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinney et al. (US 5,808,662).

As to claim 7, the claimed wherein the memory storage device includes at digital video disc (DVD) player. The Kinney et al. reference discloses media file 115 is a storage device that contains enough memory to store a movie (3:42-43). Media file 115 may take many forms including, but not limited to, CD ROM, a floppy disk, a hard disk, an optical disk, a read only memory (ROM), a random access memory (RAM), or a direct access storage device (DASD) (3:49-53). However, the Kinney et al. reference does not specifically disclose the use of digital video disc (DVD). Nevertheless, the examiner gives Official Notice that it is notoriously well known in the art to distribute media using digital video discs for the purpose of providing higher quality images and a medium capable of storing larger quantities of data. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Kinney et al. media file accordingly for the stated advantages.

As to claim 8, the claimed wherein the information includes chapter information associated with the DVD. The Kinney et al. reference discloses media file 115 is a storage device that contains enough memory to store a movie (3:42-43). Media file 115 may take many forms including, but not limited to, CD ROM, a floppy disk, a hard disk, an optical disk, a read only memory (ROM), a random access memory (RAM), or a direct access storage device (DASD) (3:49-53). The Kinney et al. reference also discloses block 270 forwards a seek event to

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the participant that is joining the viewing session in order to synchronize the new participant with the other participants (8:15-18). However, the Kinney et al. reference does not specifically disclose a seek command including chapter information associated with the DVD. Nevertheless, the examiner gives Official Notice that it is notoriously well known in the art to jump to certain portions of a DVD using chapter information for the purpose of providing an readily available to facilitate seek operations in a media file. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Kinney et al. seek event accordingly for the stated advantages.

As to claim 16, please see rejection of claim 7.

As to claim 17, please see rejection of claim 8.

7. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinney et al. (US 5,808,662) in further view of Swix et al. (US 6,609,253 B1).

As to claim 6, note the Kinney et al. reference discloses allowing users to control playback of a movie being viewed by users in different locations by the transmission of various event data such as a hello event for joining a simultaneous viewing session. However, the Kinney et al. reference does not specifically disclose transmitting when the playback of the event is to end on each of the client apparatuses. Now note the Swix et al. reference that discloses a method and system for providing interactive media VCR control. The claimed "wherein the information includes an ending time when the playback of the event is to end on each of the client apparatuses" is met by "...the present invention establishes a viewing time window in which a subscriber can watch an ordered program, enables the subscriber to freely pause, rewind, and fast-forward the program so long as the end of the program does not exceed the end of the

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window” (Swix et al. 3:60-67) and the service provider determines the appropriate multiplier for calculation of a viewing time window (Swix et al. 4:46-52), the end time. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Kinney et al. transmitted timing information associated with the joining of a simultaneous play back session with the Swix et al. end time for the purpose of preventing the program from ending beyond the viewing time window to ensure that viewing of a program can be completed within a designated time.

As to claim 15, please see rejection of claim 6.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The McPherson et al. reference (US 6,591,420 B1) discloses remote control system for audio and video content.

The Garfinkle reference (US 5,400,402) discloses system for limiting use of down-loaded video-on-demand data.

The Mages et al. reference (US 6,035,329) discloses a method of securing playback of a DVD-ROM via triggering data sent via a cable network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (703) 305-8099. The examiner can normally be reached on 8:00 am - 5:00 pm.

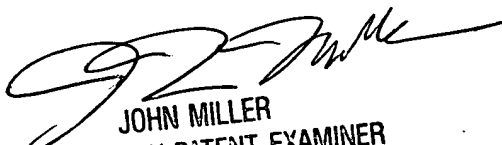


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jm

  
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